

REMARKS

The present application was filed on December 28, 2001 with claims 1-49. Claims 1-6, 11, 12, 17-20, 28, 31 and 32 remain pending. Claim 1 is the only pending independent claim.

Claims 1-6, 11, 12, 17, 19, 20, 28 and 32 are rejected under 35 U.S.C. §103(a) as being unpatentable over U.S. Patent No. 5,931,908 (hereinafter “Gerba”), U.S. Patent Publication No. 2005/0132295 (hereinafter “Noll”), U.S. Patent Publication No. 2005/0015796 (hereinafter “Bruckner”), U.S. Patent Publication No. 2005/0273828 (hereinafter “Barton”), and U.S. Patent Publication No. 2002/0016965 (hereinafter “Tomsen”).

Claim 18 is rejected under 35 U.S.C. §103(a) as being unpatentable over Gerba, Noll, Bruckner, Barton and Tomsen, in view of U.S. Patent No. 6,421,726 (hereinafter “Kenner”).

Claim 31 is rejected under 35 U.S.C. §103(a) as being unpatentable over Gerba, Noll, Bruckner, Barton and Tomsen, in view of U.S. Patent No. 5,878,141 (hereinafter “Daly”).

Applicants respectfully submit that the present amendment to claim 1 places said claim in condition for allowance or at least in better form for consideration for appeal, and hence entry of the amendment is requested under 37 CFR 1.116(b)(2). Applicants are not conceding in this application that claim 1 is not patentable over the art cited by the Examiner, as the present claim amendment is only for facilitating expeditious prosecution. Applicants respectfully reserve the right to pursue this and other claims in one or more continuations and/or divisional patent applications.

Specifically, claim 1 has been amended to clarify that interactive advertising content is added only to a last commercial within a given group of commercials. Support for this limitation may be found in the specification at, for example, page 10, lines 1-7:

One issue in the airing of ITV ads and program content is the overlap of viewer interaction with one ad and the airing of subsequent ads. Advertisers who pay high rates for their ads to be aired do not want viewers who are still interacting with the previous ad to miss their content. Thus, in one preferred embodiment of the present invention, the controller schedules only one ITV ad per “pod” (i.e. a group of commercials), and the ITV ad is placed last in the pod, as advertisers typically do not mind if interactivity overlaps with a program's content.

In formulating the present rejection of claim 1, the Examiner states that “Barton discloses that adding interactive content of the commercial are placed at the last commercial of the group of

commercials,” citing paragraphs 36 and 37. Applicants respectfully submit that Barton in fact teaches away from the limitation of amended claim 1 wherein interactive advertising content is added only to a last commercial within a given group of commercials.

Even assuming that the “teaser” disclosed in the relied-upon portion of Barton could in fact be characterized as interactive advertising content recited in claim 1, Barton suggests an arrangement in which the teaser is added during the first few seconds of a commercial break in addition to, if not instead of, the last few seconds of a commercial break. Accordingly, Barton fails to supplement the remaining references relied upon so as to reach the limitations of claim 1. See Barton at paragraphs 34-37 (emphasis added):

[0034] Often, the time span 507 from the end of the program 501 to the point where the viewer has pressed the button 503 is tens of seconds long. Thus, the first few seconds of any commercial break become extremely valuable as an opportunity to get the viewer to NOT skip the commercial break. Advertisers will pay additional money for the opportunity to occupy this space in the commercial breaks.

[0035] Similarly, when fast-forwarding or skipping, it is typical that the viewer will not be able to precisely skip to the beginning of the program material 505. When examining viewer behavior, most viewers will skip forward 506, then back up 504 into the preceding commercial break a few seconds in order to view all of the program material from the point where it starts 505. Therefore, the last few seconds of a commercial break 508 become extremely valuable, since it is an opportunity to persuade the viewer to rewind into the commercial break and view advertisements.

[0036] Referring to FIG. 6, the invention provides a method wherein the first few seconds 601 or last few 602, are carefully authored to provide a “teaser” to entice the viewer to watch multiple commercials during the break 603. This teaser might be a set of images or logos that indicate a commercial relating to that advertiser is present or a menu or short sequence of animations to designed catch the viewer's attention and persuade him to watch the commercial break.

[0037] With respect to FIG. 7, advertisers can also place the more important content in the first 702 or last 703 number of seconds of their commercials 701. This content will be able to get the desired message across to the viewer in those seconds. Given this model, content providers are able to charge advertisers a higher rate to place their commercials at the beginning or the end of a commercial break.

Even if Barton did contain a teaching or suggestion directed to an arrangement wherein a teaser is added only to the last few seconds of a given group of commercials, Barton teaches away

from such an arrangement by disclosing that adding a teaser to the first few seconds instead of or in addition to the last few seconds is at least as desirable, if not more so. It should be noted that the arrangements suggested by Barton fail to provide the aforementioned advantages associated with embodiments of the present invention, such as solving the problem of overlap of viewer interaction with one ad and the airing of subsequent ads, in which advertisers who pay high rates for their ads to be aired do not want viewers who are still interacting with the previous ad to miss their content.

Moreover, even if Barton could be combined with the remaining references of record so as to meet the limitations of claim 1, one having skill in the art would not have motivated to have done so. As the Supreme Court recently reiterated, “a patent composed of several elements is not proved obvious merely by demonstrating that each of its elements was, independently, known in the prior art. . . . This is so because inventions in most, if not all, instances rely upon building blocks long since uncovered, and claimed discoveries almost of necessity will be combinations of what, in some sense, is already known.” *KSR International Co. v. Teleflex Inc.*, 127 SCt 1727, 82 USPQ2d 1385, 1396 (U.S. 2007).

On page 8 of the present Office Action, the Examiner contends that it would have been obvious to have incorporated the teachings of Barton “in order to have viewers watch more commercials.” Applicants initially note that this appears to be precisely the sort of conclusory statement repeatedly rejected by the Supreme Court and the Federal Circuit. See, e.g., *KSR*, 82 USPQ2d at 1396 (quoting *In re Kahn*, 441 F.3d 977, 988, 78 USPQ2d 1329, 1336 (Fed. Cir. 2006) (“[R]ejections on obviousness grounds cannot be sustained by mere conclusory statements; instead, there must be some articulated reasoning with some rational underpinning to support the legal conclusion of obviousness”))

More particularly, illustrative embodiments of the present invention advantageously ensure that viewers who are still interacting with a previous ad miss content presented in a subsequent ad. By contrast, the preferred embodiment of Barton involves the placement of a teaser in the first few seconds of a commercial break, and hence would in fact exacerbate the very problem to which that embodiment of the present invention is directed.

Therefore, as noted above, Barton in fact teaches away from the limitations of claim 1. As recently noted by the Supreme Court, “when the prior art teaches away from combining certain known elements, discovery of a successful means of combining them is more likely to be

nonobvious.” *KSR*, 82 USPQ2d at 1395 (citing *United States v. Adams*, 383 U.S. 39, 51-52, 148 USPQ 479, 484 (1966))

Accordingly, amended claim 1 is believed to be patentably non-obvious over the combined references of record.

Dependent claims 2-6, 11, 12, 17-20, 28, 31 and 32 are believed to be patentable at least by virtue of their dependency from independent claim 1. Moreover, these claims also recite separately patentable subject matter.

In view of the above, Applicants believe that the pending claims are in condition for allowance, and respectfully request withdrawal of the §103(a) rejections.

Respectfully submitted,

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